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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,274	06/21/2000	Christopher John Wraight	AP32556-071838	6407

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EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

26

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/598,274	Applicant(s) WRAIGHT ET AL.	
	Examiner Karen A. Lacourciere	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45, 46, 49-60, 64-77, 79, 80, 82-87 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 45, 46, 49-60, 64-77, 79, 80 and 82-87 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Application/Control Number: 09/598,274

Page 2

Art Unit: 1635

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05-01-2003 has been entered.

Terminal Disclaimer

The terminal disclaimer filed on May 1, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,248,741 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

The rejection of record of claims 76, 77, 79, 80 and 82-87 set forth in the prior Office Action (mailed 11-01-2002) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of US Patent No. 6,284,741 is withdrawn, in response to the Terminal Disclaimer filed May 1, 2003.

Claim Objections

Claim 51 is objected to because of the following informalities: In line one of claim 51, after the phrase Claim 45, the word "herein" should be corrected to read "wherein". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The rejection of record of claims 45, 46, 49-60, 64-77, 79, 80 and 82-87 under 35 U.S.C. 112, second paragraph is withdrawn in response to Applicant's amendments filed May 1, 2003.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 64-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 64 recites "one or more nucleic acid molecules or selected from the group consisting of" bridging lines 2 and 3 of the claim. It is unclear if the claim intends to recite contacting skin with additional, unrecited, agents, besides nucleic acid molecules. Deletion of the word "or" from this phrase would obviate this rejection. Claims 65-75 are indefinite for the same reasons due to dependence on claim 64.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 45, 46, 49-60, 64-77, 79, 80, and 82-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Applicant's amendments filed May 1, 2003, adds the limitation "chemical modification of any one of said nucleic acid molecules, wherein said modification produces a nucleic acid molecule having a length and nucleotide sequence which is the same as the nucleic acid molecule prior to modification" to claims 45, 64 and 76. Support for this new limitation could not be found in the originally filed specification or claims, nor did Applicant point to any specific support for this limitation and, therefore, it is considered to be new matter. Claims 46, 49-60, 65-75, 77, 79, 80 and 82-87 also encompass this new matter, by dependence on claims 45, 64 or 76 and are rejected to for the same reasons.

Claim Rejections - 35 USC § 102

The rejection of record of claims 76 and 79 under 35 U.S.C. 102(b) as being anticipated by Baserga et al.(U.S. Patent No. 5,643,788) is withdrawn in response to Applicant's amendments filed May 1, 2003.

The rejection of record of claims 76 and 79 under 35 U.S.C. 102(b) as being anticipated by Delafontaine is withdrawn in response to Applicant's amendments filed May 1, 2003.

The rejection of record of claims 76 and 79 under 35 U.S.C. 102(b) as being anticipated by Low et al. (WO 98/22579) is withdrawn in response to Applicant's amendments filed May 1, 2003.

The rejection of record of claims 76 and 79 under 35 U.S.C. 102(e) as being anticipated by Low et al. (U.S. Patent No. 6,071,891) is withdrawn in response to Applicant's amendments filed May 1, 2003.

The rejection of record of claim 69 under 35 U.S.C. 102(b) as being anticipated by Werther et al. (reference WO 96/01636) is withdrawn in response to Applicant's amendments filed May 1, 2003.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45, 46, 49, 50, 51, 54 and 64-66 are maintained as rejected under 35 U.S.C. 102(b) as being anticipated by Werther et al. (reference WO 96/01636 on PTO form 1449, filed March 16, 2001).

Werther et al. disclose methods of treatment for proliferative and inflammatory skin disorders, including psoriasis, using an antisense oligonucleotide consisting of SEQ ID NO: 10 (SEQ ID NO:10 of Werther et al.), in a pharmaceutically acceptable carrier. Therefore, Werther et al. anticipates claims 45, 46, 49, 50, 51, 54 and 64-66.

Claim Rejections - 35 USC § 103

The rejection of record of claims 45, 46, 50, 52, 64, 65 and 67 under 35 U.S.C. 103(a) as being unpatentable over Werther et al. (U.S. Patent No. 5,929,040, cited on PTO form 1449, filed September 25, 2000) in view of Low et al. (U.S. Patent No. 6,071,891), Low et al. (WO 98/22579), Delafontaine, or Baserga et al. is withdrawn in response to Applicant's amendments filed May 1, 2003.

Response to Arguments

Applicant's arguments filed May 1, 2003 have been fully considered but they are not persuasive. In response to the rejection of record of claims 45-51, 54, 61-66, 69 76, 78 and 81 under 35 USC 102 (b) as anticipated by Werther et al. (WO 96/01636), Applicant argues the amendments filed May 1, 2003 limit the claims to methods that use nucleic acids consisting of the same length and sequence as the specific SEQ ID NO.'s claimed and therefore, the claims do not encompass the methods disclosed by Werther et al. This argument is persuasive with regard to claim 69, drawn to methods using SEQ ID NO: 14, however, claims 45, 46, 50, 52, 64, 65 and 67 are drawn to methods that use SEQ ID NO:10. Werther et al. disclose these methods wherein a nucleic acid consisting of SEQ ID NO: 10 is used and, therefore, the rejection is maintained for claims 45, 46, 50, 52, 64, 65 and 67. Applicant has not provided any arguments to traverse the rejection of record as it applies to methods of treatment of a skin disorder

Art Unit: 1635

using an antisense molecule consisting of SEQ ID NO: 10, as encompassed in claims 45, 46, 50, 52, 64, 65 and 67.

Conclusion


Any rejection of record not repeated herein is considered to be withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached at (703) 308-0447. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere
July 8, 2003


KAREN LACOURCIERE
PATENT EXAMINER